UNITED STATES PATENT AND TRADEMARK OFFICE

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1   UNITED STATES PATENT AND TRADEMARK OFFICE

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4   BEFORE THE BOARD OF PATENT APPEALS

5   AND INTERFERENCES

6   _____

7

8   *Ex parte* ARTHUR ERNEST CONRAD, GREGORY J. DECKER, and

9   JOSEPH F. CELANO

10   _____

11

12   Appeal 2008-0602

13   Application 09/903,976

14   Technology Center 3600

15   _____

16

17   Decided: February 29, 2008

18   _____

19

20   Before HUBERT C. LORIN, ANTON W. FETTING, and

21   JOSEPH A. FISCHETTI, *Administrative Patent Judges.*

22   FETTING, *Administrative Patent Judge.*

23   DECISION ON APPEAL

24   STATEMENT OF CASE

25   Arthur Ernest Conrad, Gregory J. Decker, and Joseph F. Celano

26   (Appellants) seek review under 35 U.S.C. § 134 of a final rejection of claims

27   1-44, the only claims pending in the application on appeal.

1   We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)

2   (2002).

3   We REVERSE and ENTER A NEW GROUND UNDER 37 C.F.R. §

4   41.50(b).

5   The Appellants invented a system for displaying content, as directed

6   by a process referred to as a web attract loop, on a display of a user

7   computer. The system transmits a web page to a user computer in response

8   to a request. The web page includes the web attract loop code which

9   monitors the user computer for a user event, and if the user event does not

10   occur within a specified time period, the attract loop code automatically

11   transmits a request for attract loop content to the central computer. The

12   central computer automatically transmits attract loop content to the user

13   computer in response to the request, and the attract loop code causes the

14   attract loop content to be displayed on the display of the user computer

15   (Specification 4-5:¶ 0012).

16   An understanding of the invention can be derived from a reading of

17   exemplary claim 44, which is reproduced below (bracketed matter and some

18   paragraphing added).

19   44. A method for displaying web content on a display of a user
20   computer, said method comprising the steps of:

21   [1] receiving a request to transmit a web page; and

22   [2] transmitting a web page to the user computer in response to
23   the request to transmit a web page,

24   the web page comprising attract loop code and attract
25   loop content,

26   wherein the attract loop code monitors the user computer
27   for a user event, and

1   only if the user event does not occur within a specified

2   time period,

3   the attract loop code automatically causes the

4   attract loop content to be displayed on the display

5   of the user computer.

6

7   This appeal arises from the Examiner's Final Rejection, mailed July

8 12, 2006. The Appellants filed an Appeal Brief in support of the appeal on

9 December 14, 2006. An Examiner's Answer to the Appeal Brief was mailed

10 on April 5, 2007. A Reply Brief was filed on June 5, 2007.

11   PRIOR ART

12   The Examiner relies upon the following prior art:

13   Park   US 6,295,061 B1   Sep. 25, 2001

14 David Barboza, *An internet newcomer is making money by selling moving*
15 *ads as part of screen savers*, The New York Times, (Oct. 1, 1996), at D7.

16

17   We also discuss the following art in this Decision.

18   Gerszberg   US 6,084,583   Jul. 4, 2000
19   Cho   US 6,834,048 B1   Dec. 21, 2004

20   REJECTIONS

21   Claims 1-6, 8-16, 18-28, 30-38, and 40-44 stand rejected under 35

22 U.S.C. § 102(e) as anticipated by Park.

23   Claims 7, 17, 29, and 39 stand rejected under 35 U.S.C. § 103(a) as

24 unpatentable over Park and Barboza.

1   ISSUES

2   The issues pertinent to this appeal are

3   •   Whether the Appellants have sustained their burden of showing that

4   the Examiner erred in rejecting claims 1-6, 8-16, 18-28, 30-38, and

5   40-44 under 35 U.S.C. § 102(e) as anticipated by Park.

6   •   Whether the Appellants have sustained their burden of showing that

7   the Examiner erred in rejecting claims 7, 17, 29, and 39 under 35

8   U.S.C. § 103(a) as unpatentable over Park and Barboza.

9   The pertinent issue turns on whether Park describes code that

10   monitors for a user event, and only if the user event does not occur within a

11   specified time period, the code automatically causes certain content to be

12   displayed.

13   FACTS PERTINENT TO THE ISSUES

14   The following enumerated Findings of Fact (FF) are supported by a

15   preponderance of the evidence.

16   *Park*

17   01.   Park is directed to dynamically and interactively displaying

18   images near a pointer or cursor in response to the movement or

19   activity of a pointing device (Park 3:59-62).

20   02.   Park describes a lapse of time as among the set of standard

21   events its pointing device will consider to be a predefined activity

22   which may change the display of an advertisement (Park 9:58-65;

23   Fig. 9).

1   03.   Park does not describe any activity that would terminate a

2   standard activity, such as an elapsed period of time, other than the

3   occurrence of that event. Thus, if an elapse of time is a standard

4   event, whatever is to occur upon that event's occurrence occurs in

5   Park, irrespective of any other event.

6   *Barboza*

7   04.   Barboza describes the Pointcast news and information service

8   which it supplies with advertisements (Barboza 7-10) and delivers

9   through its channel viewer, which also acts as a screen saver

10   (Barboza 15-17).

11   *Facts Related To The Level Of Skill In The Art*

12   05.   Neither the Examiner nor the Appellants has addressed the level

13   of ordinary skill in the pertinent arts of tracking items and data

14   formatting. We will therefore consider the cited prior art as

15   representative of the level of ordinary skill in the art. *See Okajima*

16   *v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) ("[T]he

17   absence of specific findings on the level of skill in the art does not

18   give rise to reversible error 'where the prior art itself reflects an

19   appropriate level and a need for testimony is not shown'")

20   (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755

21   F.2d 158, 163 (Fed. Cir. 1985) (Fed. Cir. 1985).

22   *Facts Related To Secondary Considerations*

23   06.   There is no evidence on record of secondary considerations of

24   non-obviousness for our consideration.

1 PRINCIPLES OF LAW

2 *Claim Construction*

3   During examination of a patent application, pending claims are

4 given their broadest reasonable construction consistent with the

5 specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In*

6 *re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

7   Limitations appearing in the specification but not recited in the claim

8 are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d

9 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted "in view of the

10 specification" without importing limitations from the specification into the

11 claims unnecessarily).

12   Although a patent applicant is entitled to be his or her own

13 lexicographer of patent claim terms, in *ex parte* prosecution it must be

14 within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant

15 must do so by placing such definitions in the specification with sufficient

16 clarity to provide a person of ordinary skill in the art with clear and precise

17 notice of the meaning that is to be construed. *See also In re Paulsen*, 30

18 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the

19 specific terms used to describe the invention, this must be done with

20 reasonable clarity, deliberateness, and precision; where an inventor chooses

21 to give terms uncommon meanings, the inventor must set out any

22 uncommon definition in some manner within the patent disclosure so as to

23 give one of ordinary skill in the art notice of the change).

24 *Anticipation*

1   "A claim is anticipated only if each and every element as set forth in

2   the claim is found, either expressly or inherently described, in a single prior

3   art reference." *Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed.

4   Cir. 1987). "When a claim covers several structures or compositions, either

5   generically or as alternatives, the claim is deemed anticipated if any of the

6   structures or compositions within the scope of the claim is known in the

7   prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001). "The

8   identical invention must be shown in as complete detail as is contained in the

9   ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir.

10   1989). The elements must be arranged as required by the claim, but this is

11   not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In

12   re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

13   *Obviousness*
14   A claimed invention is unpatentable if the differences between it and

15   the prior art are "such that the subject matter as a whole would have been

16   obvious at the time the invention was made to a person having ordinary skill

17   in the art." 35 U.S.C. § 103(a) (2000); *KSR Int'l v. Teleflex Inc.*, 127 S.Ct.

18   1727, 1729-30 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14

19   (1966).

20   In *Graham*, the Court held that that the obviousness analysis is

21   bottomed on several basic factual inquiries: "[(1)] the scope and content of

22   the prior art are to be determined; [(2)] differences between the prior art and

23   the claims at issue are to be ascertained; and [(3)] the level of ordinary skill

24   in the pertinent art resolved." 383 U.S. at 17. *See also KSR Int'l v. Teleflex*

25   *Inc.*, 127 S.Ct. at 1734. "The combination of familiar elements according to

1   known methods is likely to be obvious when it does no more than yield

2   predictable results." *KSR*, at 1739.

3   "When a work is available in one field of endeavor, design incentives

4   and other market forces can prompt variations of it, either in the same field

5   or in a different one. If a person of ordinary skill in the art can implement a

6   predictable variation, § 103 likely bars its patentability." *Id*. at 1740.

7   "For the same reason, if a technique has been used to improve one

8   device, and a person of ordinary skill in the art would recognize that it would

9   improve similar devices in the same way, using the technique is obvious

10 unless its actual application is beyond his or her skill." *Id.*

11   "Under the correct analysis, any need or problem known in the field

12 of endeavor at the time of invention and addressed by the patent can provide

13 a reason for combining the elements in the manner claimed." *Id.* at 1742.

14   ANALYSIS

15 *Claims 1-6, 8-16, 18-28, 30-38, and 40-44 rejected under 35 U.S.C. § 102(e)*

16   *as anticipated by Park.*

17   The Appellants argue these claims as a group.

18   Accordingly, we select claim 1 as representative of the group.

19 37 C.F.R. § 41.37(c)(1)(vii) (2007).

20   The Examiner found that Park anticipated claim 1 (Answer 3-4).

21   The Appellants contend that Park does not monitor for a user event,

22 and only if the user event does not occur within a specified time period, the

23 code automatically causes certain content to be displayed (Appeal Br. 11-

24 13). In particular, the Appellants argue that Park's elapsed time event is a

1   simple timer and is not reset by another event. As a result, the code that

2   automatically causes display is not monitoring user events and not executing

3   the display only if a user event does not occur within a specified time period

4   (Appeal Br. 13).

5   The Examiner responds that Park 9:62 – 10:6 describes a lapse of time

6   as an activity that can cause a display. The Examiner finds that Park is not

7   just a timer, but displays advertisements if non-movement of a mouse is

8   detected for a certain period of time (Answer 8). The Appellants respond in

9   turn that although Park may display an advertisement after an elapse in time,

10 this occurs purely upon such a time lapse and there is no further criteria of

11 non-movement of a pointer for such a display (Reply Br. 2-3).

12   We agree. While Park does describe displaying advertisements in

13 response to predefined activities (FF 01) and using time lapse as one of those

14 activities (FF 02), Park does not describe anything that would create the only

15 if condition required in claim 1 (FF 03). The portion cited by the Examiner

16 of Park states

17   Moreover, the pointing device activity further includes a
18   combination of standard events such as *a lapse of time*
19   *regardless of any user's pointing device activity*. Further
20   examples of such activities include an X trace with pointing
21   device 12 (FIG. 11), shaking pointing device 12 (FIG. 13), an O
22   trace made by pointing device 12 (see FIG. 10) or various
23   shapes of traces with the pointing device, lapse of certain time,
24   movement of cursor in a certain area within the working
25   window, a scroll of the working window, etc. Thus, the present
26   invention can be easily programed [sic] to recognize various
27   forms of activities for implementation. [Emphasis not in
28   original.]

1   (Park 9:62 – 10:6.) We find that the caveat to *a lapse of time* of *regardless*

2   *of any user's pointing device activity* implicitly negates the Examiner's

3   finding of non-movement of a mouse being part of this event. It may very

4   well occur that there will be no movement, but the claim requires that the

5   display occur only if, not simply if, there is no movement. It may also occur

6   that movement of a pointer would itself trigger a display, but the plain

7   reading of Park implies that the timer will still cause its display at the end of

8   the time lapse. Thus, the Examiner has erred in finding that Park describes

9   code that monitors for a user event, and only if the user event does not occur

10   within a specified time period, the code automatically causes certain content

11   to be displayed.

12   The Appellants have sustained their burden of showing that the

13   Examiner erred in rejecting claims 1-6, 8-16, 18-28, 30-38, and 40-44 under

14   35 U.S.C. § 102(e) as anticipated by Park.

15   *Claims 7, 17, 29, and 39 rejected under 35 U.S.C. § 103(a) as unpatentable*

16   *over Park and Barboza.*

17   These claims recite the same limitation of code that monitors for a

18   user event, and only if the user event does not occur within a specified time

19   period, the code automatically causes certain content to be displayed.

20   Although Barboza mentions a screen saver, Barboza provides no details, and

21   the Examiner has not shown that Barboza describes the limitation of code

22   that monitors for a user event, and only if the user event does not occur

23   within a specified time period, the code automatically causes certain content

24   to be displayed.

1   The Appellant has argued that these claims are patentable for the same

2   reasons as claim 1, and therefore has similarly sustained its burden of

3   showing that the Examiner erred in rejecting claims 7, 17, 29, and 39 under

4   35 U.S.C. § 103(a) as unpatentable over Park and Barboza.

CONCLUSIONS OF LAW

6   The Appellants have sustained their burden of showing that the

7   Examiner erred in rejecting claims 1-44 under 35 U.S.C. § 103(a) as

8   unpatentable over the prior art.

NEW GROUND OF REJECTION

10   The following new ground of rejection is entered pursuant to

11   37 C.F.R. § 41.50(b).

12   Independent claims 1, 11, 21, 22, 23, 33, 43, and 44 are rejected under

13   35 U.S.C. § 103(a) as unpatentable over Gerszberg and Cho.

ADDITIONAL FACTS PERTINENT TO THE ISSUES

15   The following additional enumerated Findings of Fact (FF) are

16   supported by a preponderance of the evidence.

17   *Gerszberg*

18   07.   Gerszberg is directed to the use of interactive commercials as a

19   screen saver. According to one embodiment, an advertisement is

20   periodically moved about the touch screen display after a

21   predetermined period of time after there is no input activity from

22   the device (Gerszberg 2:29-40).

1   08. Gerszberg's controller may connect to a personal computer

2   (Gerszberg 4:13-25).

3   09. Each of the devices connected to Gerszberg's device may be

4   connected to the internet and use TCP/IP, the internet

5   communication protocol (Gerszberg 5:28-40).

6   10. Gerszberg describes connecting to a central computer

7   (Gerszberg 6:36-48; Fig. 4A).

8   11. Gerszberg's central computer sends updated screen saver

9   content to the phone (Gerszberg 8:26-29).

10   12. Gerszberg describes the logic of its screen saver as monitoring

11   activity, and only when no activity has been detected for a

12   predetermined period of time, displaying a screen saver content

13   (Gerszberg 8:43-65; Fig. 6).

14   13. Gerszberg describes updating the screen saver content by

15   having the device having the display call for new content after the

16   existing content has been displayed for some period of time

17   (Gerszberg 9:8-11).

18   *Cho*

19   14. Cho is directed to initiating an internet telephone service from a

20   web page with Voice over internet protocol (VoIP) technology

21   (Cho 33-60).

22   ANALYSIS

23   All of the independent claims have substantially the same limitations.

24   We analyze how Gerszberg and Cho render claim 1 unpatentable. The

1 analysis of patentability for claim 1 is then applicable to the remaining

2 independent claims in this rejection. The facts of Gerszberg and Cho

3 describe claim 1 limitations as follows.

4   1. A system for displaying a web content on a display of a user
5   computer, said system comprising:

6   a central computer; [FF 10]

7   software executing on said central computer for receiving a
8   request to transmit a web page; [Gerszberg describes receiving
9   a request to transmit content to a phone (FF 13); Cho describes
10   using a web page for phone service and VOIP (FF 14)]

11   software executing on said central computer for transmitting a
12   web page to the user computer in response to the request to
13   transmit a web page, [FF 11]

14   the web page comprising attract loop code, wherein the attract
15   loop code monitors the user computer for a user event, and only
16   if the user event does not occur within a specified time period,
17   the attract loop code automatically transmits a request for
18   attract loop content to said central computer; [FF 12]

19   software executing on said central computer for automatically
20   transmitting attract loop content to the user computer in
21   response to the request for attract loop content; and [FF 12]

22   wherein the attract loop code causes the attract loop content to
23   be displayed on the display of the user computer [FF 12].

24   Basically, Gerszberg describes all of the limitations of claim 1, and in

25 particular, a screen saver, including the details of the programming logic that

26 both monitors for activity and displays content only if such activity is not

27 provided within a specific period of time [FF 12] and having the client call

28 for screen saver content from the server [FF 13], except for the transmission

29 of a web page. Gerszberg's transmission may be internet content, which

30 would suggest web content. Cho demonstrates that Gerszberg's videophone

31 may be a computer using VOIP with web pages. Thus, Gerszberg's

1 screensaver on Cho's VOIP videophone would use web pages for its

2 downloaded content to be compatible with Cho's web pages. It would have

3 been obvious to a person of ordinary skill in the art to have applied

4 Gerszberg's videophone within Cho's VOIP context because of Cho's taught

5 application to phone service.

6   The Examiner should consider the patentability of the dependent

7 claims under Gerszberg, Cho, and the remaining art of record.

8   DECISION

9   To summarize, our decision is as follows:

10 • The rejection of claims 1-6, 8-16, 18-28, 30-38, and 40-44 under 35

11   U.S.C. § 102(e) as anticipated by Park is not sustained.

12 • The rejection of claims 7, 17, 29, and 39 under 35 U.S.C. § 103(a) as

13   unpatentable over Park and Barboza is not sustained.

14 • The following new ground of rejection is entered pursuant to 37

15   C.F.R. § 41.50(b).

16   o Independent claims 1, 11, 21, 22, 23, 33, 43, and 44 are rejected

17   under 35 U.S.C. § 103(a) as unpatentable over Gerszberg and

18   Cho.

19   No time period for taking any subsequent action in connection with

20 this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

21   REVERSED; 37 C.F.R. § 41.50(b)

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